

REMARKS/ARGUMENTS

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

The Applicant has amended claims. The Applicant respectfully submits that the amendments to the claim set are fully supported by the originally filed specification.

Claim Rejections – 35 USC § 103

At page 2 of the Advisory Office Action, the Examiner rejects claims 1 and 7 under 35 U.S.C. §103 as being unpatentable over Wolff et al (U.S. Patent No. 6,081,261) in view of Bennett et al (US Patent 5,051,736), further in view of Patterson, Jr et al (US Patent 5,797,002) and further in view of Ur (US Patent Number 6,072,871).

In particular, the Examiner states that that the limitation of the printing step is irrelevant to the receiving step in claim 1, and thus the printing step is treated as non-functional descriptive material.

In order to obtain expeditious acceptance of the current application, claim 1 has now been amended to explicitly recite a step of providing the auction buyer the form by printing the form. This step also includes recording the association at the time of printing which was previously in the receiving step. Furthermore, the identifying step has been amended to clarify that the at least one parameter is identified using the indicating data and the association. Support for this amendment can be found at page 13, lines 7 to 13.

Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

Obviousness can only be established by combining or modifying teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

In particular, the MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

In regard to the first requirement of a prima facie case of obviousness, we highlight to the Examiner MPEP §2141.02 under the heading "*Prior art must be considered in its entirety, including disclosures that teach away from the claims*", which states:

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)"

The fact that the Examiner continues to ignore portions of the prior art documents which lead away from the claimed invention indicates that the prior art documents are not being considered as a whole. We again reiterate below each portion of the prior art references which lead away from the claimed method.

Wolff et al states at lines 52 to 58 of column 4 that:

"Step 512 establishes the location of the written entry by using the gyroscopic rate information. By knowing the location of the bar-code page identification and by integrating gyroscopic velocity information, the location of place at which pen pressure is exerted in step 506. This information is used to locate the corresponding electronic entry on the electronic graphical display."

Wolff et al teaches that the location of the sensing device is solely determined using gyroscopes. Wolff relies on determining a location by using a single barcode in order to determine an initial position, and then uses the gyroscopic rate information to determine the position of the sensing device. Therefore, Wolff et al as a whole leads away from the claimed method as it solely determines position on the form using gyroscopes.

Bennet et al states at lines 5 to 7 of column 5 that:

"The stylus may be used on the surface of an optically transparent thin sheet of glass or plastic that constitutes the passive digitizing tablet."

Additionally at lines 31 to 33 of column 5, Bennet et al states:

"The image 6 is an example of the reproduction on the display of the image 5 traced on the tablet."

Bennet et al teaches that a stylus and tablet may be used to determine an X-Y coordinate on the surface of the tablet. However, the tablet is transparent and thus no information is printed on the tablet. Bennet et al teaches that the system is only for reproducing the traced imaged on the display. Therefore, there is no interaction with any information provided to the user, which contrasts to the claimed method wherein information printed on the form allows the user to sense coded data associated with the information to identify at least one parameter of a bid transaction. Thus, Bennet et al as a whole leads away from the claimed method as no information is printed on the tablet.

Ur states at lines 19 to 21 of column 4 that:

"...embedded in the printed document is a unique identifying code pattern assigned to the particular authorized copy of the software."

Ur states that the unique code is only associated with the software, and therefore any printed document will only be indicative of the identity of the software. Thus, if a first unique identifying code pattern was sensed from a first printed document and then a second unique identifying code pattern was sensed from a second printed document, the only information which could be determined from the patterns is the authenticity of the software which printed the document. Ur fails to disclose that the identifying code pattern is unique to each printed document. In fact Ur teaches the very opposite as the object of the system disclosed by Ur is to authenticate the software printing the documents, and not the documents themselves. Thus, Ur as a whole leads away from the claimed method as Ur is related to determining the authenticity of the software which prints documents and fails to disclose an identity of the printed document.

In summary, Wolff et al, Bennet et al and Ur as a whole lead away from the claimed method. Thus, a skilled person in the art would not consider combining the cited documents to obtain the claimed method as each document leads away from this conclusion.

We highlight to the Examiner MPEP 2141.02 under the heading "*The claimed invention as a whole must be considered*", which states:

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)"

The fact that the Examiner has needed to combine four unrelated disclosures to reject claim 1 as obvious indicates that the Examiner is not considering each citation as a whole in light of the above portions which lead away from the claimed method.

We respectfully submit, that due to the highlighted portions of the citations which lead away from the claimed invention, there is no suggestion or motivation in the references themselves to modify the reference or to combine reference teachings. The system disclosed by Wolff et al would require radical restructuring of the sensing device and the paper document to determine a position of the sensing device using coded data. Bennet et al would additionally require a radical change to the purpose of the invention which is to provide a reproduction of a trace on the tablet, and further would require a radical change to the manufacture of the tablet where information would need to be printed on the tablet which would be highly inefficient and highly expensive. Ur would further require radical restructuring of the software to print the patterns such that the unique identifying code pattern was not only indicative of the authenticity of the software that printed the document, but additionally be indicative of the identity of the printed document.

Thus, we respectfully submit that the Examiner has failed to meet the first requirement of a prima facie case of obviousness, as stated under MPEP §2143.

Additionally, as Wolff et al, Bennet et al and Ur would require radical restructuring of the systems in order to accomplish the claimed method, there would not be a reasonable expectation of success. Essential features of the citations such as the gyroscopes of Wolff et al would need to be eliminated and substituted in order to work in the same way as the claimed method. None of the documents disclose a reasonable expectation of success of eliminating and substituting such essential features such as the gyroscope for Wolff et al.

Thus, we respectfully submit that the Examiner has failed to meet the second requirement of a prima facie case of obviousness, as stated under MPEP §2143.

Furthermore, as claim 1 has been amended to specify that the method includes an explicit step of providing a form by printing and recording an association between the spatial extent and type of coded data and the visual information, the citations fail to teach or suggest all the claim limitations of the claimed method.

Thus, we respectfully submit that the Examiner has failed to meet the third requirement of a prima facie case of obviousness, as stated under MPEP §2143.

As the first, second and third requirements of a prima facie case of obviousness has not been met, we respectfully request that the Examiner reconsider and withdraw the rejection.

If the Examiner wishes to maintain the prima facie case of obviousness, we would appreciate if each an every requirement stated under MPEP §2143 is discussed in the next Office Action.

We additionally note that a number of the dependent claims include patentable material over the citations. In particular, claim 3 specifies that the computer system receives movement data of the sensing device relative to the form, wherein the sensing device senses its movement relative to the form using at least some of the coded data.

The Examiner has stated that this feature of movement data is shown by Wolff et al. However, we respectfully submit that the Examiner is not considering all the limitations of the claim, specifically that the movement data is determined using at least some of the coded data. Wolff et al states at lines 52 to 58 of column 4 that movement of the pen is achieved using gyroscopic rate information based on gyroscopes and accelerometers. Wolff et al does not therefore use sensed coded data to determine movement of the sensing device.

Wolff et al directly teaches that movement must be determined using additional sensing techniques such as gyroscopes and accelerometers. A person skilled in the art would consider gyroscopes an essential part of the prior art system to determine the movement and therefore this part of the prior art could not possibly be eliminated. It would not be obvious for someone skilled in the art to eliminate the gyroscope and still be able to determine the movement of the sensing device relative to the page. In contrast to Wolff et al, which requires one sensor for determining movement and another sensor for scanning the coded data, the current invention provides a system using a single sensing device to concurrently sense the coded data and determine the movement of the sensing device. Therefore, claim 3 is patentable over Wolff et al.

The feature of the relative movement being determined using the sensed coded data provides a number of economic and technical advantages that would not be possible using the teachings of Wolff et al, and represents a major development over the citations.

More conventional methods use gyroscopes (such as Wolff et al) and accelerometers attached to the sensing device, which can be costly. However, allowing the sensing device to determine its relative movement using the sensed coded data rather than gyroscopes or accelerometers provides a more economical system that can determine relative movement to the form. Sensors are cheaper compared to gyroscopes, and avoid requirements for separate bar code and movement sensors, therefore providing significant advantages over the prior art.

Furthermore, the current invention provides a reduction in the number of mechanical parts necessary in the sensing device in order for the system to function. Wolff et al requires a gyroscope in order to determine the gyroscopic rate information. However, the current system eliminates this part of the sensing device by using the sensed coded data to determine the relative movement. This is a major advantage as the method is more economical to produce, the sensing device is lighter providing an ease of use for the user, and there are less mechanical parts that can be damaged when compared to Wolff et al.

Additionally, the current method provides the advantage of higher accuracy for determining the movement of the sensing device relative to the form compared to the prior art. The current system can include a large number of reference points dispersed over a form. As a result, movement can be determined at any location based on sensing of the reference points at that location thereby allowing movement to be determined to a high degree of accuracy. In contrast, gyroscopic based sensor systems such as those of Wolff et al, movement is monitored relative to a single predefined location. As a result, any inaccuracy in the sensed movement will accumulate as the sensing device moves from the predefined location so that, over the length of an entire page, the inaccuracy in the movement sensed accumulates, providing a large degree of inaccuracy. This disadvantage of gyroscopic sensors is in contrast to the current invention which measures absolute movement according to the sensed coded data on the page.

Furthermore, the current method provides the advantage of a single step process of determining relative interaction between the sensing device and form rather than a two step process described by the prior art. Wolff et al requires a first step of scanning an initial position on the page, and a second step of moving the sensing device. However, this is in contrast to the current method which allows the sensing device to be operatively used on the form while concurrently being able to determine the movement. Therefore users are not required to scan a particular initial position on the page, but can scan wherever on the page they like because the movement can be determined anywhere on the form. This feature provides the benefits of reducing a two step process into a one step process, and additionally provides significant time efficiency benefits and ease of use for the user as the interaction of the sensing device with the form is more intuitive when compared to the prior art's requirement of scanning an initial position.

Determining the relative movement of the sensing device using the sensed coded data is a prominent feature that represents notable progress in the technical field. As the current method is more economical to produce and requires less mechanical parts to function correctly, we respectfully submit to the Examiner that claim 3 is patentable over Wolff et al, and thus the combined citations.

Reconsideration and withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

Applicants:



PAUL LAPSTUN



JACQUELINE ANNE LAPSTUN



KIA SILVERBROOK

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: kia.silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9555 7762